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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,316	01/25/2002	Samson Mil'shtein	2328.2005-001	1899
21005	7590	05/20/2005	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			UPRETI, ASHUTOSH	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,316	<b>Applicant(s)</b> MIL'SHTEIN ET AL.	
	<b>Examiner</b> Ashutosh Upreti	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.  
     4a) Of the above claim(s) 14-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/02</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I (claims 1-13) in the reply filed on December 8, 2004 is acknowledged.

Claims 14-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 8, 2004.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figure 5 is informal and is not of a standard fit for publication. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities:

On lines 2-3, "object of patterns" is ungrammatical (changing the word "of" to either "consisting of", "comprising of", or "including" would cure this problem).

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helot (U.S. Patent 6,504,945) in view of Butler (U.S. Patent 4,357,597).

As to claim 1, Helot discloses a device to register a biometric object for viewing (column 4, line 37), the device comprising:

a guide for aligning the biometric object (column 4, lines 55-57) to view a region of the object in a substantially non-distorted state (Figure 4, here the portion of the finger from which a fingerprint is taken, is not pressed against any surface and is therefore undistorted) the guide including rails in which at least a portion of the object is aligned when resting therein (Figure 1, element 26, is a finger supporting region, the sides of which are considered to be a rail as they are designed to enclose the desired portion of the finger), the rail of the guide including a window for viewing corresponding surface region of the object (Figure 1, element 28 and column 4, lines 38-40); the rail being movably attached to a base (Figure 1, element 23 is a spring that moves the rail in relation to a fixed base, element 25).

Helot does not expressly disclose multiple rails for viewing multiple surface regions of the biometric object. Also not disclosed, is a base to which each of the

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multiple rails is movably attached, the base including least one window for viewing a surface pattern on the object.

As to the guide including multiple rails for viewing multiple surface regions of the biometric object, the examiner takes official notice that it is well known in the art to use the prints or images of multiple fingers, palms and even the entire hand (meaning five finger prints plus a palm print or some similar variation), in place of a single fingerprint image. Handprints are often used biometric identification systems for entry into secure areas. As to a base to which each of the multiple rails is movably attached, if multiple rails are used in the device as discussed above, they would clearly be attached in some way to the base. As for rails being movably attached, that is discussed above in Helot.

It would have been obvious to a person of ordinary skill in the art to make a guide for multiple surface regions of a biometric object (e.g. a hand) instead of just one surface (e.g. a single finger). A skilled artisan would be motivated to do this, as it would make a biometric identification system more robust, by requiring a greater amount of biometric data to be matched for positive identification.

Butler discloses a base including least one window for viewing a surface pattern on the object (Figure 2, element 14 is a base and element 18 is a window for viewing a palm).

It would have been obvious to a person of ordinary skill in the art to use an opening in the base for a palm print as in Butler, in the fingerprint imaging of Helot as they both deal with the use of biometric hand data for identification. This would enable even more biometric information to be gathered about a person meaning the device

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could be used in applications where a fingerprint is not sufficient, thus providing motivation.

As to claim 2, Helot as applied above further discloses that the guide is capable of aligning different-sized but similarly-shaped objects (column 5, lines 26-30, here a thumb is of similar shape to a finger but is of different size).

As to claim 3, Helot as modified above further discloses that the guide for aligning the object is disposed between the object and a scanning device that generates images of the multiple surface regions the object through the windows (Figure 4 shows that guide is between the finger and the camera 84. The guide is moved, with the finger on it, to a position between the finger and the camera used for imaging the finger, as disclosed in column 6, lines 7-12).

As to claim 4, Helot as applied above further discloses that the object loosely registered in the guide is identified based on at least one unique pattern as viewed through an opening of the guide (column 4, lines 38-40).

As to claim 5, Helot as applied above further discloses that a unique object is identified based on a biometric pattern (column 6, lines 31-32) of exposed flesh through a window of the guide (Figure 4).

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As to claim 6, Helot as applied above discloses a hand in which patterns of fingers are viewed through windows of the rails (see the rejection of claim 5 above and column 5, lines 26-30) and patterns on a palm are viewed through a window in the base (see the rejection of claim 1 regarding a window for palm viewing).

As to claim 7, Helot as applied above further discloses a camera that produces an image of the object of patterns viewed through the windows of the guide to identify the object (column 6, line 11 has a camera being used but does not disclose a scanner). The examiner takes official notice that it is well known in the art for a scanner to be used in place of a camera to obtain images of a hand.

It would have been obvious to a person of ordinary skill in the art to use a scanner, as scanners are commonly used for obtaining fingerprints. Helot discloses, in column 3, lines 13-14, that any appropriate imaging device may be used, as this is not a critical aspect of the invention, thus providing motivation.

As to claim 8, the identifying cited in claim 5 means that the images of the object as viewed through the windows are inherently compared to images stored in a database.

As to claim 9, Helot as modified above discloses the object being a human hand (as fingers and palms are being imaged – see claim 1 rejection) and the guide being

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able to take different sized fingers (see claim 2 rejection). Note that length is to be considered an aspect of finger size.

Helot does not expressly disclose adjusting the guide based on finger size.

Butler as applied above, further discloses adjusting a guide to accommodate different hand sizes (column 2, lines 31-33). Being able to accommodate different hand sizes means a device must be able to accommodate different finger sizes, as hands of different sizes can also have fingers of different sizes.

It would have been obvious to a person of ordinary skill in the art to adjust the guide in Helot based on hand/finger size as is done in Butler, as they both involve biometric identification using parts of the human hand. This would enable more people to use the system, thus providing motivation.

As to claim 10, Helot as applied above further discloses that a person associated with a hand can be identified based upon a biometric pattern (column 1, lines 27-28 and 31-32) viewed through at least one window (see claim 4 rejection).

As to claim 11, Helot as applied above discloses undistorted surface patterns of biometric matter are viewed through a window (Figure 4, here the portion of the finger from which the fingerprint pattern is imaged is undistorted. Also see the rejection of claim 4).



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As to claim 12, Helot as applied above discloses a window, which is a void in the material from which the guide is formed (see the rejection of claim 1, particularly Figure 1, element 28).

As to claim 13, a guide being made of plastic is considered to be a design choice and is therefore unpatentable. It is considered to be a design choice as other materials such as wood or metal could be used instead of plastic, without effecting the main function of the device.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

DiMaria (U.S. Patent 5,995,014) discloses the use of fingerprint and handprint scanners (column 3, lines 55-60).

Fujimoto (U.S. Patent 5,177,802) discloses obtaining the image of a finger in a substantially non-distorted state (Figure 12).

### ***Contact Details***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashutosh Upreti whose telephone number is (571) 272-7428. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (571) 272-7414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.U.

AU

May 16, 2005

  
Jon Chang  
Primary Examiner